Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed December 5, 2003. A Petition for Extension of Time to Respond is submitted herewith, together with the appropriate fee.

Claims 1-51 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 1-51. The present Response amends claim 46 and adds new claims 52-61, leaving for the Examiner's present consideration claims 1-61. Reconsideration of the rejections is requested.

1.   Summary of Examiners Rejections

Claims 15-16 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-2, 4, 6, and 11-16 were rejected under 35 U.S.C. 102(e) as being anticipated by Koppolu et al. (U.S. Patent No. 5,801,701).

Claims 3, 5, 7-10, 17-25, 28-36, 39-40, 42-48, and 51 were rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu et al. as applied to Claim 1, in view of Vertelney et al. (U.S. Patent No. 5,341,293).

Claims 26-27, 37-38, and 49-50 were rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu et al. in view of Vertelney et al. as applied to Claim 25, and further in view of Hoirup et al. (U.S. Patent No. 6,397,054).

Claim 41 was rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu et al. in view of Vertelney et al. as applied to Claim 40 and further in view of Cohen et al. (U.S. Patent No. 6,324,543).

2.   Summary of Applicants Response

Applicants traverse the 35 U.S.C. 112 rejections.

Applicants traverse the 35 U.S.C. 102 and 103 rejections.

Applicants amend claim 46.

Applicants add claims 42-51

3.   Response to Rejections

A.   Claims 15-16 (112 Rejections)

Claims 15-16 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse the rejections. The Examiner, in providing the rejection states that element b of claim 15, which recites "b) an application interface layer configured to receive the document from the bit provider and provide the document to an application." cannot be located in the application. However, Applicants submit that support for these features can be found in FIGURE 1, and the discussion thereof, particularly, page 11, line 21 through page 13 line 6. This section discusses an application interface layer that is accessed either through Document Management System (DMS) compliant browsers or through the translator layer 13 of FIGURE 1. The text states "A DMS document interface provides access to documents typically as Java objects. Applications make use of this interface by importing the relevant package in their Java

- 16 -

code and coding to the API provided for accessing documents and properties. The DMS document interface provides document and property classes with specialized subclasses supporting all of the functionality, such as collections, access to web documents, etc.". In light of the above disclosure, applicants submit that claims 15-16 are enabled.

B. Claims 1-39

1. Independent Claims

Claims 1-39 recite systems and methods for:

a document using a data source having an associated property and content information identifying the data source as having the associated property;

retrieving the content information from the identified data source; and

providing the retrieved content information as at least a portion of the document.

The present invention discloses a system that generates custom documents that represent entities such as devices, documents, or people as documents that can be interacted with and utilized through a traditional document interface. A bit provider maintains an association between properties of the documents and information on the data sources. This enables a user to transparently access and manipulate information on the data sources through the document. When a user for example, accesses a document, the document management system is configured to locate the associated data from the data source and load it into the document. This process is described in greater detail in the section of specification labeled "Bit Providers" ranging from page 17, line 18 to page 19, line 16.

Koppulu is deficient of any mention of " an associated property" or a process by which a data source is identified as having particular properties. Rather, Koppulu describes a compound document system through which information is stored. Users can manually copy information from a spreadsheet to a clipboard and then transfer it to a compound document.

The system of Koppulu does not maintain any association between the data source and the document. For example, if changes were made to the original data source, the compound document of Koppulu would not reflect the changes to the original source data.

All of the other cited references are similarly deficient of any reference to an associated property. Thus applicants submit that claims 1-39 are patentably distinguishable over the cited references.

2. Claims 8, 10, 18, 19

In addition to the patentable subject matter of claim 1, claims 8 , 10, 18 and 19 recite that the data source is a camera or a phone. The Examiner, in rejecting claims 8 and 18, cites a section of Vertelney in which a phone book is stored. While Vertelney does mention a phone book, there is no mention of *the phone as a data source.* There is no teaching or suggestion in Vertelney that the phone book information is taken from a phone or that any information in the phone book is retrieved from the phone in response to a detected association between the phone and the document.

Likewise, with claims 10 and 19, the Examiner cites a section of Vertelney in which images are modified, however there is no teaching or suggestion in Vertelney that

information is identified as being located within a camera and subsequently accessed from a camera.

In light of the above, Applicants respectfully submit that the Examiner has not met the prima facie case for obviousness with regards to claims 8, 10, 18, and 19.

C. Claims 40-51

Independent claims 40, 43, and 46 are rejected under Koppolu in view of Vertelney. These claims, in addition to the patentable subject matter of claim 1, additionally recite methods for representing a computation process as a document and systems for representing hiring and travel approval processes.

In his rejection of claim 40, the Examiner does not discuss the limitation of a document representing a computational process, instead discussing the limitations of claim 43 (a travel approval process)

In his rejections of claims 40, 43, 46, the Examiner concedes that neither Koppulu or Vertelney disclose the limitations of the claimed invention, but maintains that it would have been obvious to one skilled in the art. Applicants submit that the Examiner has not met the prima facie case for obviousness that requires that "the prior art references (or references, when combined *must teach or suggest all of the claim limitations*". MPEP 706.02(j) (emphasis added).

The Examiner does not cite any location in either Koppulu or Vertelney that teaches or suggests the creation of a document to represent a travel approval process, computational process, or hiring process. The Examiner concedes that neither Vertelney nor Koppolu

- 19 -

disclose these limitations, but insists that because Vertelney discloses the general topic of business projects, that the claimed invention would be obvious. However, Applicants submit that the claimed limitations must be found in the references themselves. "All words in a claim must be considered in judging the patentability of the claim against the prior art."*In re Wilson, 424 F.2d. 1382, 1385.*

The cited prior art is particularly deficient in the case of claim 40 which is directed towards the representation of computational processes such as RMI registries and kernels. These processes particularly fall outside the manner of project disclosed in Vertelney.

In light of the above, Applicants respectfully submit that claims 40, 43, and 46, and their respective dependent claims are patentably distinguishable over the prior art and respectfully request that the Examiner withdraw his rejections.

D. Claims 52-61

In addition to the patentable subject matter of claim 1, claim 52 additionally recites that the step of identifying the associated property is independent of a specific user request and that the step of retrieving the content information is performed in response to identifying the data source as having the associated property. Koppulu is clearly deficient of these features as Koppolu discloses a system whereby a document is copied manually to a clipboard and then loaded into a compound document in response to specific user requests. The document in Koppulu can only be constructed as a result of a direct user action to assemble the document from the constituent data sources. The other cited art is likewise

deficient. In light of the above, Applicants respectfully submit that claims 52-61 are patentably distinguishable over the prior art.

E. Note Regarding 103 Rejections

Finally, Applicants note that none of the Examiner's 103 rejections find any motivation to combine implicitly or explicitly within the cited references. The Examiner provides *benefits* for adding these features, but such benefits are insufficient to render a claim obvious. *Any* feature having patentable utility is beneficial, however such a benefit is insufficient to render the addition of the feature obvious to one skilled in the art. The Federal Circuit has stated "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification.....* it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re* Fritch, 972 F.2d 1260 (Fed. Cir. 1992)
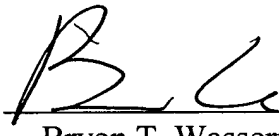
F. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

- 21 -

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136 for extending the time to respond up to and including June 5, 2004. The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: _June 2, 2004_   By: _____
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- 22 -